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*Duval
Biller
Upde/02*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **URANO et al.**

Serial No.: **09/810,650**

Group Art Unit: **1626**

Filed: **March 15, 2001**

Examiner: **Laura Lynne Stockton**

FOR: **DIAZODISULFONES**

P.T.O. CONFIRMATION NO.: **8670**

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SUPPLEMENTAL SUBMISSION

Commissioner for Patents
TECH CENTER 1600
Washington, D.C. 20231

May 31, 2002

Sir:

As a supplemental to their Response filed May 22, 2002, Applicants submit the following documents:

- (1) Declaration of Albert Tockman (4 copies)
- (2) Certificated of Service (4 copies)
- (3) Response of May 22, 2002 (1 copy)

Respectfully Submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP

Scott M. Daniels
Scott M. Daniels
Attorney for Applicant
Reg. No. 32,562

SMD/plb

Atty. Docket No. **910094RI**



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PATENT TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application/Reexamination of: **URANO** et al.

U.S. Patent No. **5,216,135**

Reexamination Control No.: **90/004,812**

Filed: **October 23, 1997**

Reissue Serial Number: **09/810,650**

Art Unit: **1626**

Issue Date: **June 1, 1993**

Examiner: **Laura Lynne Stockton**

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DECLARATION

TECH CENTER 1600/2900

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U.S. PATENT AND TRADEMARK OFFICE
100 BRADLEY PLACE
SUITE 100
ALEXANDRIA, VA 22314-1100

1. I received a Ph.D. in organic chemistry from Northwestern University in 1954.
2. After receiving that degree, I was employed in industry synthesizing organic compounds. Working with me were laboratory assistants having undergraduate degrees in chemistry.
3. I was given copies of and have read the following materials:

The PRELIMINARY AMENDMENT dated March 15, 2001, in the Reissue Application of U.S. Patent No. 5,216,135;

The RESPONSE dated May 22, 2002, in that Application;

U.S. Patent No. 5,216,135;

A translation of Japanese Patent Application No. 2-19614; and

The DECISION in IN RE WAKO PURE CHEMICAL INDUSTRIES LTD, dated February 1, 2001.

4. The definition of R^1_0 and R^2_0 in formula [I] of the Japanese Patent Application is inclusive of "a C_{1-10} straight chain, branched or cyclic alkyl group." R^1_0 and R^2_0 are further defined at page 14 of that Application (as translated) as inclusive of "methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl group."
5. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula [I] in the Japanese Patent Application where each of R^1_0 and R^2_0 is a cyclohexyl

group (claim 8) and where each of R_0^1 and R_0^2 are a branched butyl group (claim 9).

6. Based on my extensive experience in matters relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience synthesizing organic compounds would know that "a C₁₋₁₀ straight-chain, branched or cyclic alkyl group" is shorthand for and inclusive of each and every such alkyl group having 1-10 carbon atoms. This is particularly the case in view of the further description of the straight chain, branched or cyclic alkyl group at page 14 of the Japanese Application.
7. The paragraph bridging pages 2-3 of the DECISION reads, in part, "The written description requirement does not dictate that the applicant describe the invention exactly. Rather, what is required is that... the inventor convey with reasonably clarity to those skilled in the art that the inventor was in possession of the subject matter claimed."
8. It is my further opinion that the Japanese Patent Application establishes to an organic chemist of ordinary skill in the art that the inventors in the Japanese Patent Application were in possession of the compounds described in claims 8 and 9 of the Amendment.

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The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful statements jeopardize the validity of the application or any patent issuing thereon.

Signed this 30th day of May, 2002.

Albert Tockman
Albert Tockman

In re the merged Reexamination and Reissue of:

URANO et al.

U.S. Patent: **5,216,135**

Reexamination Control Number: **90/004,812**

Filed: **October 23, 1997**

Reissue Serial Number: **09/810,650**

Filed: **March 15, 2001**

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TO
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CERTIFICATE OF SERVICE

I certify that one copy of

(1) Supplemental Submission of May 31, 2002

was served by First Class Mail postage prepaid this 31st day of May, 2002 on the third party requestor, addressed as follows:

Judith A. Evans
Jones & Valentine
12200 Sunrise Valley Drive
Suite 150
Reston, VA 20191

Scott Daniels

Scott M. Daniels
Reg. No. 32,562